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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,454	01/27/2004	Tatsuhiko Saitoh	50395-247	8678

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McDERMOTT, WILL & EMERY
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Washington, DC 20005-3096

EXAMINER

DEGHAN, QUEENIE S

ART UNIT	PAPER NUMBER
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1731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/764,454

Applicant(s)

SAITOH ET AL.

Examiner

Queenie Dehghan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1 to 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arimondi et al. (2005/0072192) in view of Nagayama et al. (2002/0059816 and 6,400,878) and Caplen et al. (2003/0089133). Regarding claims 1 and 2, Arimondi et al. disclose a method for preparing an optical fiber perform having through holes to be formed into air holes and drawing the optical fiber perform into a fiber with the air holes ([0001], [0005], [0026], figure 1). However, Arimondi et al. do not disclose a third step of heated the optical fiber in an additional furnace. Nagayama et al. (878) teach of a step of heating the optical fiber to a temperature of 1100°C for 3 seconds (col. 12 lines

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64-67) in an additional heating furnace located downstream of a drawing furnace (col. 5 lines 46-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to heat the fiber to 1100°C for 3 seconds in an additional furnace, as taught by Nagayama et al, in the fiber drawing process of Arimondi et al. in order to ensure proper annealing, as taught by Nagayama et al. Furthermore, although Arimondi et al. disclose pumping a hydrogen free gas into the through holes of the preform during drawing ([0115]), Arimondi et al. fail to specifically disclose the presence of oxygen gas in the through holes when drawing the optical fiber preform. Caplen et al. teach filling a hole in an optical fiber preform with gases, such as oxygen and drawing the preform with oxygen filled holes ([0044], [0045]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the dry oxygen of Caplen et al. in holes of Arimondi et al. in order to keep the hole dry and to prevent contamination of the holes during drawing of the preform, as taught by Caplen et al.

4. Regarding claims 3 and 4, Arimondi et al. do not disclose a minimum temperature of the fiber between the drawing and heating furnaces. Nagayama et al. (816) teach the use of two furnaces, a drawing and heating furnace, for forming an optical fiber, where an optical fiber usually cools to about 400°C after being drawn ([0010]). Furthermore, Nagayama et al. teach cooling the fiber with air between the drawing and heating furnaces ([0058]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to heat the fiber to 1100°C as mentioned in claim 1, which is higher than the air-cooled down temperature of 400°C, as disclosed by Nagayama et al. in order to properly anneal the fiber.

5. Regarding claims 5 and 6, Nagayama et al. (816) teach of a drawing furnace filled with helium gas and a heating furnace filled with nitrogen gas ([0058], [0063]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use helium gas in the drawing furnace and nitrogen gas in the heating furnace, as taught by Nagayama et al. in the drawing process of Arimondi et al. and Nagayama et al. (878), in order to provide the atmospheres needed to soften and anneal the glass fiber with a lowered transmission loss and whose outer diameter is restrained from fluctuating, as taught by Nagayama et al.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arimondi et al. (2005/0072192) in view of Nagayama et al. (6,400,878) and Caplen et al. (2003/0089133), as applied to claim 1 above, and further in view of Kuwahara et al. (2002/0174692). Arimondi and Nagayama do not disclose a drawing temperature. Kuwahara et al. teach of drawing step at 1950°C. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilized the drawing temperature of Kuwahara et al. in the fiber making process of Arimondi et al. and Nagayama et al. in order to properly soften the glass for drawing.

Response to Arguments

7. Applicant's arguments, see page 5, filed December 4, 2006, with respect to the rejection(s) of claim(s) 7 under Arimondi have been fully considered and are persuasive. Although Arimondi disclose the presence of oxygen while sintering, it is not apparent that oxygen is present in the through holes while drawing. Therefore, the rejection has

been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Caplen et al. In regards to the applicant's argument on page 7 concerning the failure of references to establish motivation and envision the problem addressed, Caplen et al. do disclose drawing a preform with a hole filled with oxygen and realistic motivation for doing so. Furthermore, the background to the invention reciting the problem of Rayleigh scattering and its causes is not a recited feature of the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Queenie Dehghan whose telephone number is (571)272-8209. The examiner can normally be reached on Monday through Friday 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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